

## REMARKS

### INTRODUCTION:

In accordance with the foregoing, claim 23 has been added and claim 21 has been cancelled. Claims 1, 9, 12 and 22 have been amended. Support for the amendments may be found at least at paragraph [0016] of the present application and thus no new matter has been added.

Claims 1-23 are pending and under consideration. Claims 1, 9, 12, 22 and 23 are independent claims. Reconsideration of the claims in light of the present amendments and the following remarks is respectfully requested.

### REJECTIONS UNDER 35 U.S.C. § 103:

Claims 1-4, 9-10, 12-15, and 17-22 stand rejected under 35 U.S.C. §103(a) as being unpatentable over “Installing the Intel Pro/Wireless 2011 LAN PC Card in Windows 2000 Professional®” *WinBook Tech Article* – article no.: WBTA09000774 (“IntelWBTA”) in view of Sybex, *Windows 98® Complete*, pgs. 128-135 (“Sybex”). Claims 5-8, 11 and 16 stand rejected under 35 U.S.C. §103(a) as being unpatentable over IntelWBTA in view of U.S. Patent Appl. Pub. No. 2002/0042911 by Harms (“Harms”). The rejections are traversed for at least the following reasons.

Amended independent claim 1 recites at least:

copying and storing the device driver file in the computer after the installing of the device driver using the device driver file, the device driver file being stored in the computer to reinstall the device driver without providing the device driver file from the outside;

IntelWBTA, Sybex and Harms, taken separately or in combination, fail to suggest or disclose at least the above-recited features of amended independent claim 1.

The Office Action notes at page 3, first paragraph that IntelWBTA “does not explicitly recite that copying of said one driver file is such that it is after the installing in the computer of the device driver using the device driver file, for said reinstallation of the device driver.” However, the Office Action appears to propose modifying IntelWBTA based on a “known concept” as asserted below:

“In view of the Windows operating system by IntelWBTA, it was

known concept that Windows-based installation package, at the time the invention was made, include files that when installed like that of the ProWireless driver installation process would comprise an install/uninstall executable being registered/stored somewhere in the target system during the initial software installation; the example of which registering are entries in the OS Registry under 'Windows/Microsoft/CurrentVersion' path which includes keys containing themselves path of executable files generated from the initial installation and provisioned for reinstallation according to some user selection."

The Office Action appears to be taking Official Notice that all of the features included in the text directly above were known at the time the invention was made. Applicants respectfully traverse the Official Notice and request authority in the record for the statement. Applicants specifically point out the following errors in the Office Action.

First, the Office Action uses common knowledge as the principal evidence for the rejection. As explained in M.P.E.P. § 2144.03(E):

Any facts so noticed should . . . serve only to 'fill in the gaps' in an insubstantial manner which might exist in the evidentiary showing made by the Examiner to support a particular ground of rejection. It is never appropriate to rely solely on common knowledge in the art without evidentiary support in the record as the principal evidence upon which a rejection was based.

Second, the noticed facts are not considered to be common knowledge or well-known in the art. In this case, the limitation is not of notorious character or capable of instant and unquestionable demonstration as being well-known. Instead, this feature is unique to the claimed invention as Applicants have asserted herein. See M.P.E.P. § 2144.03(A) ("the notice of facts beyond the record which may be taken by the Examiner must be "capable of such instant and unquestionable demonstration as to defy dispute").

Third, the Office Action provides no evidence supporting the assertion. See M.P.E.P. § 2144.03(B), which states "there must be some form of evidence in the record to support an assertion of common knowledge."

Fourth, it appears that the rejection is based, at least in part, on personal knowledge. 37 C.F.R. § 1.104(d)(2) requires such an assertion to be supported with an affidavit when called for by the Applicant. Thus, Applicants call for support of the assertion with an affidavit.

Regardless, the Office Action proposes to modify IntelWBTA with Sybex and asserts that Sybex describes one or more of the above-recited features. Specifically, the Office Action asserts at page 3, that “Windows 98® in light of Sybex discloses “a Installer Wizard using Windows® Control panel to automatically look for hardware driver according to some class selection from the wizard.” Applicants respectfully disagree that Sybex suggests or discloses the above-recited features.

Sybex describes two techniques for loading drivers. The first technique, found on pgs. 128-132, describes a New Hardware Wizard (“Wizard”) installing a driver *stored on the hard drive of the PC* as part of the Windows 98® operating system (pg. 133, first sentence and FIG. 7.10). However, the first technique of Sybex describes loading a driver, which is clearly not the same as the above-claimed “device driver file,” because a device driver file as claimed is a file which “includes instructions to control installation of the device driver in the computer.” Accordingly, the first technique described in Sybex fails to suggest or disclose all of the above-recited features.

The second technique of Sybex, found on pgs. 133-134, describes a situation in which the Wizard cannot find an appropriate driver pre-installed on the PC as part of the Windows 98® operating system. Here, the user may use a disk having a driver thereon by clicking the “Have Disk” button of the Wizard, placing the disk in the drive and entering the location of the driver (pg. 133, steps 1, 2 and 3). However, as with IntelWBTA, the second technique of Sybex merely describes the copying of a driver from an external disc to the computer and fails to describe the copying of a disc driver file, as claimed above. Thus, the second technique of Sybex is essentially the same as that of the conventional art described in the *Description of the Related Art* section of the above-identified application.

Moreover, both the first and the second techniques of Sybex, as described above, use the Wizard to copy the device driver from a user-selected source to the computer. However, the Wizard, as noted in the Office Action at page 3, line 12, is part of the Windows 98® operating system and is therefore inherently located on the hard drive of the computer. Thus, even assuming for the sake of argument that the Wizard of Sybex describes the device driver file recited above, Sybex cannot describe “copying and storing the device driver file in the computer after the installing of the device driver using the device driver file,” because the Wizard is already located on the hard drive of the PC at the time it performs the installation of the device driver in **both** the first and the second techniques of Sybex. Accordingly, Sybex fails to suggest or disclose all of the above-recited features.

Additionally, Harms fails to compensate for the deficiencies of IntelWBTA or Sybex.

Amended independent claim 1 further recites at least:

reinstalling the device driver using the stored device driver file.

IntelWBTA, Sybex and Harms, taken separately or in combination, fail to suggest or disclose at least the above-recited features of amended independent claim 1.

The Office Action notes at page 3, that IntelWBTA “does not explicitly recite that copying of said one driver file is such that it is after the installing in the computer of the device driver using the device driver file, for said reinstallation of the device driver.”

Further, Sybex cannot describe reinstalling the device driver “using the stored device driver file” that Sybex fails to describe. In other words, Sybex, at best, describes performing an initial installation of the device driver using a device driver file provided from outside the computer and then performing a reinstallation of the device driver using the Wizard located on the hard drive of the computer. This is in contrast to the above-recited claim in which the installation and the reinstallation are each performed by the device driver file. Accordingly, Sybex fails to suggest or disclose all of the above-recited features.

Harms fails to compensate for the deficiencies of IntelWBTA or Sybex.

Accordingly, Applicants respectfully submit that independent claim 1 patentably distinguishes over IntelWBTA, Sybex and Harms, and should be allowable for at least the above-mentioned reasons. Since similar features recited by each of the independent claims 9, 12, 22 and 23, with differing scope and breadth, are also not taught or disclosed by IntelWBTA, Sybex and Harms, Applicants request the rejections be withdrawn and claims 9, 12, 22 and 23 also allowed.

Regarding the rejection of claims 2-8, 10-11 and 13-20, these claims depend directly or indirectly on one of independent claims 1, 9, and 12, and are therefore believed to be allowable for at least the reasons noted above.

#### Insufficient Reason to Modify Asserted

In light of the foregoing arguments, Applicants have clearly demonstrated that the combination of Harms, IntelWBTA and Sybex fails to describe all of the features of amended independent claim 1. However, the Office Action states that it would have been obvious to one skilled in the art at the time of the invention to modify the combination of IntelWBTA and Sybex

to arrive at the above-recited claim feature. Applicants note that the primary issue with both the current and previous Office Actions is that each fails to clearly describe for the record how one skilled in the art would have modified the combination of IntelWBTA and Sybex.

In order to further prosecution, Applicants will attempt to summarize the Office's position regarding the allegedly obvious modifications. Applicants respectfully request the Examiner to confirm that the alleged modifications are accurately described here, or to clearly describe how the Office's proposed modifications are different than those described here.

IntelWBTA describes installing a driver from an external compact disc or floppy disc using the "Found New Hardware Wizard" (Wizard #1) from Windows 2000 Professional® (page 2, item 3).

Sybex describes a "Add New Hardware Wizard" ("Wizard #2") installing a driver *stored on the hard drive of the PC* as part of the Windows 98® operating system (pg. 133, first sentence and FIG. 7.10).

Thus, the combination of IntelWBTA and Sybex, at best describes installing a driver from an external disc using a first wizard (Wizard #1) located on the hard drive of the computer and reinstalling the driver using a second wizard (Wizard #2) located on the hard drive of the computer.

Accordingly, the Office Action appears to suggest that it would have been obvious to modify the combination of IntelWBTA and Sybex in at least the following three ways:

- i. Modify the combination so that a single wizard is used to perform the installation and reinstallation of the driver.
- ii. Modify the combination so that the wizard is stored in the computer after the installing of the device driver in the computer using the wizard.
- iii. Modify the combination so that a wizard provided from a source located external to the computer is used to install the driver, rather than the wizard being already located in the memory of the computer at the time of the installation of the device driver.

Accordingly, in order for the asserted combination to have rendered independent claim 1 obvious, the combination of IntelWBTA and Sybex would have needed to be further modified in at least the three ways described above. To meet a prima facie case obviousness case, Applicants request the Office provide reasons why one skilled in the art at the time of the invention would have made each of the necessary combinations/modifications, as described in more detail below.

Insufficient Reason to Combine Asserted

To establish a prima facie case of obviousness, there must be some suggestion or reason, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. *MPEP* 2142. Further, there must be a reasonable expectation of success. *MPEP* 2143.02. Based on the foregoing, Applicants respectfully submit that the rejection fails to establish a prima facie case of obviousness.

Here, no citation to the prior art has been offered as providing a suggestion or reason to modify Harms, IntelWBTA and Sybex, nor does the Office Action provide evidence demonstrating an implicit motivation to modify the documents. In *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 127 SCt 1727, 167 LEd2d 705 (U.S. 2007), the U.S. Supreme Court held that in determining obviousness, it is necessary “to determine whether there was an apparent reason to combine the known elements in the fashion claimed” *KSR*, slip op. 14, 82 USPQ2d at 1396. Further, “there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR* at 1396, quoting *In re Kahn*. The reasoning provided in the Office Action for combining IntelWBTA and Sybex states:

“Based on such known concept implemented in the above Windows installation registry concept, It would have been obvious for one [sic] skill in the art at the time the invention was made to implement to file copying during IntelWBTA so that one of the file copied over the target device comprises executable needed to support the reinstall/uninstall as taught by Sybex or Windows98 whereby the initial driver installation as by IntelWBTA would registers or provides a Reinstall directory (searchable via a path name within the target system) as set forth above, providing thereby the user with the chance to and the utility for reinstalling the software when an unwanted or critical software driver-related situation require so, for the benefit such that this would expedite the reactivation or recovery the software driver without recourse to an external retrieval of that driver, as contemplated by the very reinstall provision in the Registry.”

Applicant asserts that the cited rationale for combining IntelWBTA and Sybex is merely a conclusion and therefore fails to meet the standard articulated by the Supreme Court in *KSR International Co. v. Teleflex Inc.*

For example, the Office Action asserts one skilled in the art would have made the combination of IntelWBTA and Sybex “for the benefit such that this would expedite the reactivation or recovery the software driver without recourse to an external retrieval of that driver.” However, neither IntelWBTA nor Sybex explicitly recognize the problem or benefit relied

upon in the Office Action. In fact, the problem and benefit asserted in the Office Action comes from the Background of the present application. By way of example and not limitation, paragraph [0004] of the present application states:

If a problem occurs in the printer driver installed in the computer or a problem occurs in the computer so that the printer driver has to be installed again, the above-described conventional method of installing the printer driver requires the CD including the printer driver file. In other words, in the case where the CD, which is provided when purchasing a printer, is lost, the conventional method of installing the printer driver cannot be used to re-install the printer driver.

Accordingly, the Office Action cites a benefit described in the present application as the reason for combining IntelWBTA and Sybex. Applicants respectfully submit that this amounts to an improper reliance on Applicants' own disclosure. As another non-limiting example, the present invention as claimed provides for reinstallation of the device driver without requiring installation instructions from a source located external to the computer. An example of a source located external to the computer would include a disc located in the drive of the computer.

Furthermore, in order for the asserted combination to have rendered independent claim 1 obvious, the combination of IntelWBTA and Sybex would have needed to be further modified in at least the three ways described above. The Office Action fails to provide a reason why one skilled in the art would have made the necessary modifications.

in *KSR* the Supreme Court held that in determining obviousness, one "must ask whether the improvement is more than the predictable use of prior art elements according to their established functions" slip op. 13, 82 USPQ2d at 1396.

The rejection is traversed because as demonstrated above, the claimed features recite more than the predictable use of prior art elements. For example and as noted in the Office Action, both IntelWBTA and Sybex describe using generic wizard programs embedded in Windows® operating systems and resident on the computer to reinstall a device driver. Thus, the wizards described in IntelWBTA and Sybex are linked to the Windows® operating systems and provides no benefit to computers using other operating systems such as Linux. Furthermore, the wizards are generalized and re used to reinstall a variety of device drivers as selected by the user, thus necessarily making it more complex and more time consuming to use. In summary, Applicants assert that the wizards described in IntelWBTA and Sybex represent "the use of prior art elements according to their established functions." For the reasons described, the claimed features recite more than the predictable use of the wizards described in IntelWBTA

and Sybex.

Accordingly, one skilled in the art would not have had a reason to combine the teachings of Harms, IntelWBTA and Sybex, and the rejection under 103(a) is improper.

Accordingly, in view of the above, Applicants respectfully submit that because the combination of IntelWBTA, Sybex and Harms fails to suggest or disclose at least all of the features of amended independent claim 1, the claim is allowable and withdrawal of the rejection is respectfully requested.

If the Office elects to maintain the present rejections, Applicants request the next Office Action provide the following information in order to clarify the record for appeal.

1. A combination of references that particularly describe each and every feature recited in the present claims and a clear indication in the Office Action as to which reference is being relied on for the teaching of a particular feature.

2. A description of the modifications one skilled in the art at the time of the invention would have been made over the combination of IntelWBTA and Sybex.

3. A reason why one skilled in the art at the time of the invention would have combined the references and would have made each of the modifications necessary to support the obviousness rejection.

Without the evidence requested herein, Applicants assert the present rejections are unsupportable under the law as dictated by the U.S. Supreme Court in *KSR International Co. v. Teleflex Inc.*

#### NEW CLAIM:

New independent claims 23 has been added. Applicants respectfully assert that the new claims is also allowable and consideration of the new claim is respectfully requested.

#### REQUEST FOR INTERVIEW BEFORE NEXT OFFICE ACTION:

If the rejections are to be maintained, Applicants respectfully request the Examiner contact the undersigned attorney to discuss the pending claims before issuance of the next Office Action. Applicants believe that a more thorough review of the pending claims will be helpful in furthering prosecution.

CONCLUSION:

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

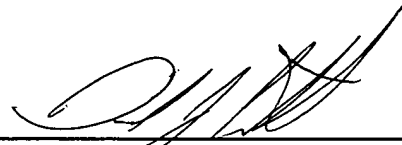
Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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